

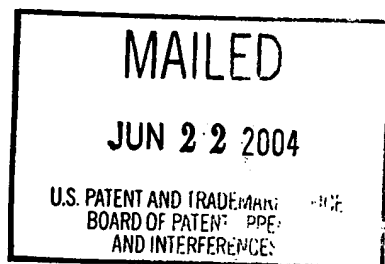
The opinion in support of the decision being entered today
was **not** written for publication in a law journal and
is **not** binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

**Ex parte TAKAYUKI HASEBE,
RYOTA AKIYAMA and MAKOTO YOSHIOKA**



Appeal No. 2004-1468
Application No. 09/476,319¹

ON BRIEF

Before BARRETT, DIXON and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-56, 111-113, and
119-125.

Invention

Appellants' invention relates to a storage medium for use as part of an electronic
data protection system for protecting software and electronically published data from
illegal copying by a third party. (Appellants specification at column 1, lines 36-40)

¹ This application is a reissue of U.S. Pat. No. 5,796,824 issued August 18, 1998, which
is based on Application No. 08/603,760 filed February 20, 1996

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Specifically, the storage medium stores encrypted electronic data, a medium personal number unique to that storage medium, and encrypted permission information. At least the medium personal number is written onto the storage medium in a form that a user computer cannot rewrite. (Appellants' Abstract)

Claim 18 is representative of the claimed invention and is reproduced as follows:

18. A storage medium accessed by a vendor compute and user computer, said storage medium for storing information readable by said user computer said storage medium comprising:

encrypted electronic data to be decrypted by the user computer;
a medium personal number which is particularly personal for each storage medium and is different from a medium personal number of another storage medium;

wherein at least the medium personal number is written onto the storage medium in an un-rewritable form which the user storage reading apparatus cannot rewrite, and said medium personal number is used for decrypting said encrypted electronic data; and

information which is encrypted based on said medium personal number and is encrypted independent from a specific apparatus number for a specific computer, said information and said medium personal number enabling said user computer to decrypt the encrypted electronic data in a manner that the user computer does not use the specific apparatus number for the specific computer in decrypting the encrypted electronic data.

References

The references relied on by the Examiner are as follows:

None.

Rejections At Issue

Claims 1-56, 111-113, and 119-125 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective detail thereof².

Contrary to Appellants' briefs and the Examiner's answer, claims 114-118 are not before us on this appeal. Claims 114-118 were canceled (paper number 19, filed June 3, 2002). Therefore, we have not considered these claims.

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1-56, 111-113, and 119-125 under 35 U.S.C. § 101.

I. Whether the Rejection of Claims 1-56, 111-113, and 119-125 Under 35 U.S.C. § 101 is proper?

It is our view, after consideration of the record before us, that claims 1-56, 111-113, and 119-125 meet the requirements of 35 U.S.C. § 101. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal each of the independent claims stand or fall separately. See page 5 of the brief. However, contrary to the Examiner's indication at page 2 of the answer, Appellants neither argue each group of

² Appellant's filed an appeal brief on September 30, 2003. Appellant's filed a reply brief on January 28, 2004. The Examiner mailed out an office communication on December 4, 2003.

claims separately nor explain why the claims of each group are believed to be separately patentable. See pages 5-12 of the brief and pages 1-5 of the reply brief. The claims form a single group because Appellants have failed to meet the requirements of 37 C.F.R. § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellant's filing of the brief. 37 C.F.R. § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in a single group, and we will treat claim 18 as a representative claim of the group. "If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim."

In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). See also **In re Watts**, 354 F.3d 1362, 1369, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

With respect to independent claim 18, the Examiner states that "[t]he instant claims are directed to non-functional descriptive matter." (Final rejection, paper number

30, page 4, line 7) The Examiner further states, “none of the storage areas provide for descriptive matter that provides for a functionality either to the data as structured or a process to be implemented on a computer.” (Final rejection, page 4, lines 13-15) We do not agree. However simple the data structure of Appellants’ storage medium, together the encrypted data and the un-rewritable number that is used to decrypt the encrypted data do provide for increased data protection. Clearly, Appellants’ storage medium comprises “a claimed computer-readable medium encoded with a data structure which defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” See MPEP § 2106 at page 2100-13.

At page 4 of the answer, the Examiner states that the claims do not recite “functional descriptive material that would cause or instruct a computer to perform step(s) that are part of a particular process or method to result in a practical application.” (emphasis added) No requirement exists in the statute for the claim to be directed to a “particular” process or method. The only requirement is that there be a practical application, i.e., a concrete, tangible, and useful result. The Examiner has not shown that the claimed invention fails to meet this requirement.

Appellants’ claim 18 dictates how the computer protects software and electronically published data from illegal copying by a third party. Thus, Appellants’ claim 18 defines functional characteristics of the storage medium. Contrary to the Examiner’s assertion, Appellants do not claim merely the data content of the storage

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medium. Appellants' data structure, while including data, depends functionally on the data content. The data structure provides increased computer protection. Nor do Appellants seek to patent the content of data resident on the storage medium. Rather, Appellants data structure imposes a physical organization on the data. **See In re Lowery**, 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994).


Therefore, we will not sustain the Examiner's rejection of claim 18 under 35 U.S.C. § 101.

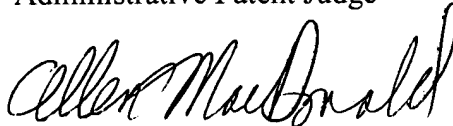
Conclusion

In view of the foregoing discussion, we have reversed the rejection under 35 U.S.C. § 101 of claims 1-56, 111-113, and 119-125.

REVERSED


LEE E. BARRETT
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge


ALLEN R. MACDONALD
Administrative Patent Judge

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